

Notice of Allowability

Application No.

10/714,577

Examiner

Rita J. Desai

Applicant(s)

BERG ET AL.

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 9/22/05.
2. ☒ The allowed claim(s) is/are 1, 2, 4, 7, 9, 10, 12, 13, 27, 29 and 30.
3. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some* c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/171570.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit
of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☒ Interview Summary (PTO-413),
Paper No./Mail Date _____
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

Art Unit: 1625

The request filed on 9/25/05 for a Continued Examination Application (RCE) under 37 CFR 1.114 based on parent Application No. 10/714,577 is acceptable and a RCE has been established. An action on the RCE follows.

EXAMINER'S AMENDMENT

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Mr. Sterner on 12/22/05 .

The application has been amended as follows:

In claim 13 and 27 after the term 5-hydroxytryptamine-mediated disorder

Insert -- wherein the disorder is selected from anxiety and depression, --.

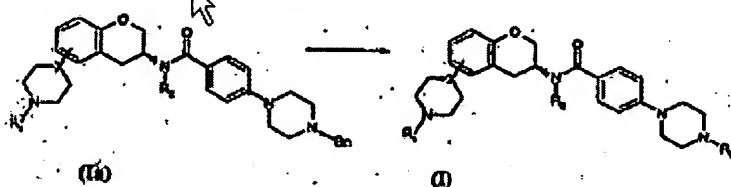
In claims 29

Cancel the whole paragraph A(iii) which is.

Art Unit: 1625

A(iii)

debenzylation, in the case wherein R_1 is C_1-C_6 alkyl or C_3-C_6 cycloalkyl, X and R_2 are as defined in claim 1 and R_3 below is C_1-C_6 alkyl, C_3-C_6 cycloalkyl, $(CH_2)_mOH$ wherein m is 2-5, or COR_4 , of a compound of formula Ia, followed by a) hydrogenation, b) alkylation, c) alkylation and removal of a protecting group or d) acylation;



Cancel claim 28, and 31-34.

Status of the claims :-

The rejection of the claims 1 under 35 USC 112 has been withdrawn.

Applicants claims are drawn to compounds wherein R_4 is a hetero group other than the a 5 or 6 membered rings with one or 2 N atoms as a hetero atom only. Applicants do have examples 34, 35 drawn to 7 membered het rings.

The rejection of the claims 13, 27 and 28 has been withdrawn since applicants have amended the claims 13 and 27 to depression and anxiety and cancelled claims 28 and new claims 31-34.

The Double Patenting rejection over US 6479497 has also been withdrawn since in the patent even though X is a N, R_4 is either a non-hetero group or a 5 or 6 membered hetero group with 1 or 2 N 's as its hetero atoms only.

The double patenting rejection over US 6387899 has also been withdrawn since the patent compounds have the R_9 and there is no motivation to modify it.

Reasons for Allowance

The following is an examiner's statement of reasons for allowance:

Thus applicants have been able to overcome all the issues.

There is not overlapping double patenting issues.

US 6670359 is drawn to compounds wherein X is a CH.

US 6479497 is drawn to compounds and process wherein X is a N however, R4 is either a non-hetero group or a 5 or 6 membered hetero group with 1 or 2 N 's as its hetero atoms only.

US 6384225 is drawn to compound wherein X can be N or CH however these compounds have an R9 on the benzopyran ring and there is no motivation to make that modification.

Thus the claims 1, 2, 4, 7, 9, 10, 12, 13 and 27, 29-30 are found to be allowable.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rita J. Desai whose telephone number is 571-272-0684. The examiner can normally be reached on Monday - Friday, 9:30 am to 6:00 pm.

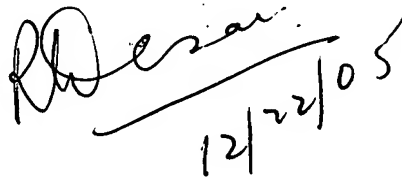
Art Unit: 1625

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Rita J. Desai
Primary Examiner
Art Unit 1625

R.D.
December 22, 2005

A handwritten signature, likely of Rita J. Desai, is written over a horizontal line. Below the signature, the date "12/22/05" is handwritten.